

**REMARKS**

The Examiner made a number of obviousness-type double patenting rejections that were addressed in applicant's prior response. This document supplements applicant's response to two of those rejections.

**Rejection based on application 10/643,296.**

The Examiner provisionally rejected claims 9 and 30 under the judicially created doctrine of obviousness-type double patenting in light of claims 1 and 8 from co-pending application 10/643,296 in light of U.S. Patent No. 4,934,233 to Brundage et al. That rejection is traversed for the reasons stated previously. Applicant further states that co-pending claim 8 has been cancelled without prejudice and co-pending claim 1 has been amended. Co-pending claim 1, as amended, does not disclose all the limitations found in claims 9 and 30 and therefore claims 9 and 30 are not obvious in light of the co-pending claim. MPEP 2143.03.

**Rejection based on application 10/052,274.**

The Examiner provisionally rejected claims 9 and 30 under the judicially created doctrine of obviousness-type double patenting in light of claim 15 from co-pending application 10/052,274 (now issued as US Patent 6,826,988) in view of Brundage. That rejection is traversed for the reasons given previously.

This rejection is also traversed because a two-way test for obviousness should have been applied. Section 804(II)(B)(1)(b) from the MPEP explains:

[W]here, through no fault of the applicant, the claims in a later filed application issue first, an obvious-type double patenting rejection is improper, in the absence of a two-way obviousness determination, because the applicant does not have complete control over the rate of progress of a patent application through the Office.

This rule is taken from the case of In re Braat, 937 F.2d 589, 19 USPQ2d 1289 (Fed. Cir. 1991). In that case, the Board of Patent Appeals and Interferences affirmed an obviousness-type double patenting rejection of an earlier-filed application in view of a commonly-assigned but later-filed patent. Both the application and the patent concerned optical record carriers such as CDs. The Board applied a one-way test for obviousness and determined that the claims at issue from the earlier-filed application were obvious in light of claims from the later-filed patent. The Federal Circuit reversed and explained that a two-way test should have been applied because the two applications could not have been filed together as one, because it was not applicant's fault that the later-filed application issued first, and because the later-filed claims were not obvious in light of the earlier-filed claims. Id. at 594, 19 USPQ2d at 1293. The court explained that the rationale behind the application of the two-way test "is that an applicant (or applicants), who files applications for basic and improvement patents should not be penalized by the rate of progress of the applications through the PTO, a matter over which the applicant does not have complete control." Id. at 593, 19 USPQ2d at 1292 (citing 3 D. Chisum, *Patents*, §9.03[2][c] (1990), and the following cases: In re Borah, 345 F.2d 1009, 148 USPQ 213 (CCPA 1966), In re Stanley, 214 F.2d 151, 102 USPQ 234 (CCPA 1954), In re Calvert, 97 F.2d 638, 38 USPQ 184 (CCPA 1938), Thomson-Houston Elec. Co. v. Elmira & Horseheads Ry. Co., 71 F. 396 (2d Cir.), cert. denied 163 U.S. 685, 16 S.Ct. 1201, 41 L.Ed.2d 315 (1896), Thomson-Houston Elec. Co. v. Ohio Brass Co., 80 F. 712 (6<sup>th</sup> Cir. 1897)).

The case of In re Berg, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998), further explains when a two-way test applies. In Berg, the Federal Circuit affirmed a

one-way double patenting rejection of genus claims in light of nearly identical species claims. The claims concerned a method of preparing abrasive particles for use as an abrasive grit. The genus and species claims were the subject of two separate applications filed the same day. The species claims issued first and the Patent Office applied a one-way test to reject the genus claims in light of the species claims. The court affirmed the double patenting rejection and the application of the one-way test because Berg could have filed all the claims in a single application but instead chose to file two separate applications on the same day. *Id.* at 1433, 46 USPQ2d at 1230.

Even though Berg affirmed the application of the one-way test, the court recognized that the two-way test applies when a later-filed improvement patent issues before an earlier-filed basic invention. Specifically, the court distinguished Braat by saying: “*Braat* ... emphasized the more typical scenario in which, despite common inventive entities, the two-way test applied: ‘when a later-filed improvement patent issues before an earlier filed basic invention.’” *Id.* at 1434, 46 USPQ2d at 1230 (quoting In re Braat, 937 F.2d at 593, 19 USPQ2d at 1292, emphasis added in Berg). The court in Berg also said the “essential concern” behind the two-way test “was to prevent rejections for obviousness-type double patenting when the applicants filed first for a basic invention and later for an improvement, but, through no fault of the applicants, the PTO decided the applications in reverse order of filing, rejecting the basic application although it would have been allowed if the applications had been decided in the order of their filing.” *Id.* at 1432, 46 USPQ2d at 1229. These statements confirm that the two-way test applies when a later-filed improvement patent issues before an earlier-filed application through no fault of applicant.

The situation in the present application is the same as in Braat and as described in Berg, and therefore, the two-way test for obviousness should apply. The present application was filed before the cited application and the cited application could not have been filed with the present application because it includes additional disclosure of later-developed material. Also, the cited claims from the later-filed application are not obvious in light of the earlier-filed claims.

The Examiner may have applied a one-way test because he thought administrative delay is required for a two-way test. However, saying administrative delay is required for the two-way test is another way of saying the two-way test applies if the administrative process, and not some action taken by the applicant, delayed issuance of the first-filed application until after issuance of the later-filed application. In re Berg, 140 F.3d at 1437, 46 USPQ2d at 1233. If the delay was no fault of applicants, or in other words, if applicant did not take some action to delay the issuance of the first application, then the Patent Office (i.e., the administrative process) is responsible for the delay. However, if applicant took some action to delay the issuance of the first application until after the second application issues, then a one-way test may be appropriate. Id.

The cases of Braat and Berg illustrate this point. In Braat the Federal Circuit applied the two-way test because it was "not [applicant's] fault that the combination claims in the [subsequent] patent issued first." Braat, 937 F.2d at 594, 19 USPQ2d at 1293. Applicant did not act to delay the issuance of the first application. In Berg the Federal Circuit did not decide whether there was delay, but gave the following examples of how an applicant could delay the issuance of a first-filed application: "filing the genus claims long after the species claims even though the two were invented at nearly the

same time or the genus claims were invented first, or by filing numerous continuations in the genus application while failing to respond substantively to PTO Office actions." In re Berg, 140 F.3d at 1434 n.6, 46 USPQ2d at 1231 n.6 (citing In re Emert, 124 F.3d 1458, 1461, 44 USPQ2d 1149, 1152 (Fed. Cir. 1997)).

The present application is similar to Braat because applicant has not acted to delay the issuance of the first application. The present application was filed first, before the cited application. The cited application was filed five months after the present application as a continuation-in-part to the present application (and to other applications). Also, the present application is not the result of multiple continuation applications, and applicant has responded substantively and promptly to each Office action. Thus, none of the acts identified in Berg by which an applicant may delay prosecution are found in the present application. On the other hand, the Patent Office did not issue a first action in the present application until 21 months after filing. These facts show that it is not applicant's fault that the claims in the later-filed application issued first, and therefore, a two-way test should be applied, as explained in Braat and Berg.

It may be that claims in a later-filed application issue before claims in an earlier-filed application simply because more time is required to determine the patentability of the earlier-filed claims. Any such delay, however, is not applicant's fault; rather, it is simply the result of the administrative process. The Federal Circuit recognized in Braat, 937 F.2d at 593, 19 USPQ2d at 1292, that applicant "should not be penalized by the rate of progress of the applications through the PTO," and therefore, any delay resulting from the administrative process is properly credited to the Patent Office.

For all these reasons, a two-way obviousness test should be applied. Under that test, the present double patenting rejection is improper and should be withdrawn.

Respectfully submitted,

SD3, LLC



David A. Fanning, Esq.  
Registration No. 33,233  
Customer No. 27630  
22409 S.W. Newland Road  
Wilsonville, Oregon 97070  
Telephone: (503) 638-6201  
Facsimile: (503) 638-8601

**CERTIFICATE OF TRANSMISSION/MAILING**

I hereby certify that this correspondence is being deposited with the U.S. Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, or facsimile transmitted to the U.S. Patent and Trademark Office to number (703) 872-9306, attention Boyer D. Ashley, on the date shown below.

Date: July 5, 2005



David A. Fanning